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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,281	09/10/2003	Lance R. Peterson	0112300-1529	5293
29159 7590 02/14/2008 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
PANDYA, SUNT				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary**Application No.**

10/660,281

Applicant(s)

PETERSON ET AL.

Examiner

SUNIT PANDYA

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 81-94 is/are pending in the application.
- 4a) Of the above claim(s) 50-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 81-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 9/6/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to amendments filed 9/6/07.

Election/Restrictions

Applicant's election without traverse of claims 1-49, and 81-94 in the reply filed on 11/19/07 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-49 and 81-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of

compending Application No. 09/934003. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applicants disclose a gaming device that has a player selectable award feature, which digit receives a second randomly generated number, until each of the positions have a number, whereby the gaming device determines the player's original award. The player can elect to modify the original award using a plurality of methods to create an ultimate award. The gaming device displays the digits, digit positions, and modification methods.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The examiner notes that the said application 09/934003, has been issued however no patent number has been issued, upon the publication of the patent with an issue number, the following double patenting rejection will change from Provisional nonstatutory obviousness-type to nonstatutory obviousness-type double patenting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 9-19, 21-49, 81-89 and 91-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US Patent 6,589,114).

Claims 1, 13, 25, 81: Rose teaches a game of chance conducted on a video gaming machine controlled by a processor in response to a wager. The game includes a plurality of symbols randomly selected for placement in a displayed symbol array. A shuffle feature is triggered in response to the displayed symbols including a sequence of value-based symbols. The sequence defines a first award. The sequence of value-based symbols is then re-ordered such that the re-ordered sequence defines a second award. The second award is awarded to the player. Furthermore, the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction, to define the award given to the player. Rose additionally discloses, a display device (figures 1, element 12), a plurality of digits displayed on the display device (figure 4), a processor which communicates with the display device, which selects and displays a plurality of digits, enables a player to select the positions, which associates numbers with the positions based on the player's selection of the positions and which determines an award based on an order of the numbers associated with the positions, wherein the award is based on a number of monetary units equal to the order of the numbers associated with the positions (figures 3-7, column 3-4, lines 51-57, and column 5, lines 1-9).

Claims 2-3, 14-15, 26-28, 30, 84-85: Rose teaches of the display device being a video display reel (reels which are projected to be circular on the game machine), not mechanical device (column 2, lines 28-30). However it is notoriously well

known in the art to adapt video reel over mechanical reels thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 4, 17, 86: Rose teaches of a gaming device which includes an initial sequence controlled by the processor for determining how many positions the player is enabled to select (columns 4-5, line 66-3).

Claims 5, 19, 87: Rose teaches of a gaming device wherein the award positions include at least a one's digit, a ten's digit and a hundred's digit (figures 3-7 and columns 4-5, lines 1-9).

Claims 6, 21, 83, 87: Rose teaches of a gaming machine, wherein the processor is programmed to enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of an award provided to the player (column 3-4, lines 51-57, and column 5, lines 1-9).

Claims 7, 88: Rose teaches of the numbers are digits and the award is a number of credits which is the order of the digits (Abstract, column 4, lines 21-25).

Claims 9-12, 22-24, 91-94: Rose teaches of a shuffle feature includes a sequence of value-based symbols that are randomly re-ordered/shuffles, with or without player interaction (such as player selection) (column 3-4, lines 51-57, and column 5, lines 1-9).

Claims 16: Rose teaches of a gaming machine wherein the processor reveals the award by displaying a number associated with each selection in the digit selected by the player (figures 3-7, column 3-4, line 51-57, and column 5, lines 1-9).

Claim 18: Rose teaches of a gaming machine which includes an initial sequence controlled by the processor for determining how many positions the player is enabled to select (columns 4-5, line 66-3).

Claim 29: Rose teaches of a gaming device which includes a plurality of selections displayed by the display device, which enables a player to associate the selections with the positions, which causes the display device to display the numbers associated with the selections that have been ordered in association with the positions (60) (62) (64) (figures 3-7, column 3-4, lines 51-57, and column 5, lines 1-9).

Claim 82: Rose teaches of a gaming device wherein a selection orderer enables the player to select and order at least two selections with digits to form an award, wherein the processor reveals the award by displaying a number associated with each selection in the digit selected by the player (column 3-4, lines 51-57, and column 5, lines 1-9).

Claim 31: Rose teaches of a gaming device comprising a cabinet (figure 1), a display device supported by the cabinet having plurality of different modification methods (the game includes a plurality of symbols randomly selected for placement in a displayed symbol array. A shuffle feature is triggered in response to the displayed symbols including a sequence of value-based symbols). An indicator disclosed within the cabinet to indicate modifications (column 3-4, lines 51-57, and column 5, lines 1-9). Rose also teaches of displaying award determined by the processor and provided to the player based on the order of the numbers arranged by the player (Abstract, column 4, lines 21-25, and Claim 6), wherein the modified award includes the award modification

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method which is the award rearrangement method (shuffle feature) (column 3-4, lines 51-57, and column 5, lines 1-9).

Rose teaches of the display device and the award indicators as being a video display, not mechanical device (column 2, lines 28-30). However it is notoriously well known in the art to adapt video display means over movable mechanical means, thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 32, 33, 35: Rose teaches of a gaming device which includes a player selectable modify input which communicates with the processor, wherein activation of the modify input initiates an award modification method, wherein the award modification method is an award rearrangement method (shuffle feature) (column 3-4, lines 51-57, and column 5, lines 1-9).

Rose teaches of the display device and the award indicators as being a video display, not mechanical device (column 2, lines 28-30). However it is notoriously well known in the art to adapt video display means over movable mechanical means, thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 34, 36-41: Rose teaches of the display device being a video display reel (wherein the reels which are projected to be circular on the game machine), are not mechanical devices (column 2, lines 28-30). However it is notoriously well known in the art to adapt video reel over mechanical reels (wherein the mechanical reels could be conformed to any shapes such as circular, prism shaped, extend latitudinally, or

longitudinally, spinning vertically or horizontally, which are all with the capabilities of video reels) thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 42-449: Rose discloses of a shuffle feature, which includes sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection, or when the processor automatically controls the feature), to define the award given to the player.

Claims 8, 20 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 6,589,114) as applied to claims above, and further in view of Hamano (U.S. 5,205,555).

Claims 8, 20, 90: Rose substantially teaches the invention as claimed however, Rose seems to lack awards being based on mathematic operation applied to digits.

Hamano teaches of a gaming machine that determines an award for a player by performing a mathematical computation of the numbers that stop on the top line of reels of a gaming machine. Hamano is analogous art because, like Rose, is an electronic gaming device.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Hamano's process for determining and calculating a player award in a gaming machine in Rose. Doing so, one would be motivated to incorporate Hamano's process for determining and calculating a player

award in Rose to provide an electronic game that is complicated and more interesting than simply relying on an award paid in response to a predetermined or player determined combination that is in a one to one, fixed relationship with a predetermined stored pay table in the gaming machine.

Response to Arguments

Applicant's arguments with respect to claims 1-49, 81-94 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SP

/Robert E. Pezzuto/
Supervisory Patent Examiner
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